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Any Dkt No. GP-302714 / GM0327PUS

### REMARKS

The following remarks are intended to be fully responsive to the Office Action mailed May 13, 2004.

Claims 1-23 are pending. Claim 1 is rejected under 35 U.S.C. § 102(b) as being anticipated by Lieftring (3,730,582). Claim 1 is also rejected under 35 U.S.C. § 102(b) as being anticipated by Bailey (2,569,218). Claims 2-17 and 19 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Bailey in view of Hayata (5,115,878). Claims 18, 20, and 22 are rejected as being unpatentable over Bailey in view of Hayata and further in view of Alamagny (2,533,752). Claims 21 and 23 are withdrawn from further consideration by the Examiner as being drawn to a non-elected invention. Applicants have amended claims 1 and 22, and added new claim 24.

#### Elections / Restrictions

In response to the restriction requirement, Applicants affirm the provisional election made by Ms. Kathryn Marra via telephone on May 7, 2004 to prosecute invention I, Species A of the vehicle body panel, claims 1-20 and 22.

#### Claim Rejections – 35 U.S.C. § 102(b)

Claim 1 is rejected under 35 U.S.C. § 102(b) as being anticipated by Lieftring. Applicants have amended claim 1 to clarify that a unitary outer panel forms both a hood portion and two fender portions. More specifically, amended claim 1 recites "a unitary outer panel, the outer panel at least partially defining a hood portion and two fender portions of the body panel. . . ." It should be noted that "unitary" is used synonymously with "one-piece" in the present application. For example, the present application recites a "unitary, i.e., one-piece, outer panel" in paragraph 0003.

The Examiner states that Lieftring "discloses a body panel (19) for a vehicle, the body panel comprising: a unitary outer panel (19), the outer panel at least partially defining a hood portion (Fig. 2) of the body panel configured to extend over and across a front compartment of the vehicle, and two fender portions (in Fig. 2 and 7 the

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panel 19, extends down to form a portion of the side fender). . . .” However, hood member 19 and fenders 8, 9 are separate pieces, as shown in Figure 7 of Lieffring, and accordingly, Lieffring does not teach a “unitary,” i.e., one-piece, “outer panel at least partially defining a hood portion and two fender portions,” as recited by claim 1. Even assuming, *arguendo*, that the side panels 12, 13 of Lieffring are “fender portions,” they are separate from hood member 19. Amended claim 1 thus recites elements and limitations that are neither taught nor suggested by Lieffring, and, accordingly, claim 1 is not anticipated by Lieffring.

Claim 1 is also rejected under 35 U.S.C. § 102(b) as being anticipated by Bailey. The Examiner states that “Bailey et al. disclose a body panel (18) for a vehicle, the body panel comprising: a unitary outer panel (18), the outer panel at least partially defining a hood portion (Fig. 2) of the body panel configured to extend over and across a front compartment of the vehicle, and two fender portions (in Fig. 1 the [sic] panel 18, extends down to form the side fenders) of the body panel extending from opposite sides of the hood portion.”

For a rejection to be proper as an anticipation under 35 U.S.C. § 102, every element and limitation found in the rejected claim must be found in the § 102 reference. “A claim is anticipated **only if each and every element** as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987) (emphasis added). See MPEP §2131.

Bailey is silent as to the construction of the hood 18; nowhere does Bailey state that hood and fender portions are formed by a “unitary,” i.e., one-piece, panel. Moreover, the drawings of Bailey are highly schematic and no construction details can be ascertained therefrom. Thus, Bailey does not expressly teach a “unitary,” i.e., one-piece, “outer panel at least partially defining a hood portion and two fender portions,” as recited by claim 1. Further, the fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In*

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*re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art); *In re Oelrich*, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981). See also MPEP § 2112. Thus, Bailey also does not inherently teach a “unitary,” i.e., one-piece, “outer panel defining a hood portion and two fender portions.” Therefore, Applicants submit that claim 1 is not anticipated by Bailey.

Claims 2-7 ultimately depend from claim 1 and are therefore allowable for at least the same reasons that claim 1 is allowable.

Claim Rejections – 35 U.S.C. § 103(a)

Claims 2-17 and 19 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Bailey in view of Hayata. Claim 2 recites “a unitary inner panel operatively connected to the outer panel and further defining the hood portion and the two fender portions.” The Examiner admits that Bailey “does not disclose that the hood panel includes an inner panel (claims 2, 8).” The Examiner further states that “Hayata discloses a body hood panel with an outer member and an inner member (claims 2 and 8). . . .”

A proper rejection under 35 U.S.C. § 103(a) requires that the Examiner establish *prima facie* obviousness. As recited in the MPEP, “[t]he examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.” MPEP § 2142.

Three basic criteria must be met to establish *prima facie* obviousness. MPEP § 2143. First, there must be some suggestion or motivation to modify a reference or combine teachings. *Id.* Second, there must be reasonable expectation of success. *Id.* Third, the prior art reference or references must teach or suggest all the claim limitations. *Id.*

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Applicants submit that the Examiner has not satisfied the basic criteria necessary to establish *prima facie* obviousness with respect to claim 2. With respect to the third criterion, claim 2 recites that the "inner panel ... further define[s] the hood portion and the two fender portions." However, the inner panel 3 of Hayata merely defines, in cooperation with outer panel 4, a hood; the inner panel 3 of Hayata clearly does not further define two fender portions, as recited by claim 2. Thus, claim 2 recites limitations that are neither taught nor suggested by the references cited by the Examiner, and accordingly the third criterion necessary to establish *prima facie* obviousness is not satisfied.

Furthermore, the Examiner states that one of ordinary skill in the art would have been motivated to combine the inner panel of Hayata with the vehicle of Bailey "to have a hood panel that could absorb impact energy in the event of a collision with an object that is taller than the bumper." However, the inner panel of Hayata absorbs impact energy by providing "a laterally extending indentation 11 molded or otherwise formed therein. The indentation 11 forms a fold region extending laterally. . . . Indentation 11 is located in what is referred to as a central region, or middle portion, of the inner panel 3 and divides the inner panel into a front region, between the front end of the vehicle body 1 and the indentation 11, and a rear region, between the indentation 11 and the windshield 9 of the vehicle. The impact of a head on crash causes the middle part of the vehicle hood 2 to bend." Hayata, column 2, line 57 – column 3, line 4 (emphasis added).

This energy absorbing mechanism taught by Hayata is unlikely to work in the hood of Bailey for several reasons. First, Bailey includes "apertured blocks 34 mounted on the interior of the shell 18 in immediate connection with the bumper 31 so that when the pins 32 are lodged within the brackets 33 and blocks 34 the bumper 31 is quite rigidly locked to the frame 7." See Bailey, column 3, lines 35-40 (emphasis added). It is thus apparent that the front region of the hood 18 of Bailey is rigidly connected to the chassis frame 7 via blocks 34 and pins 32. This rigid locking of the front region of the

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hood 18 would restrict or prevent relative movement between the "front region" of the inner panel of Hayata and the rigid frame 7 in a head on crash, thus preventing bending or folding of the inner panel at the indentation 11 in the middle portion of the hood. Second, if the inner panel "further defines the hood and fender portions" as recited by claim 1, the fender portions of the inner panel would further restrict or prevent folding of the inner panel along the indentation 11. Thus, since there is no reason to believe that the two references could be combined in an operative manner, there is no expectation of success, and the second criterion necessary to establish *prima facie* obviousness is not satisfied. Indeed, Hayata requires that the front region of the hood and inner panel be deformable to absorb energy, and therefore Hayata teaches away from combining the inner panel of Hayata with the hood 18 of Bailey. See Hayata, column 4, lines 10-14: "The impact of a head on crash is ... concentrated in and absorbed by the weaker front region of the hood forward of the indentation." Therefore, Applicants respectfully submit that the rejection of claim 2 is improper, and that claim 2 is allowable.

Claim 8 also recites "a unitary outer panel at least partially defining the hood portion [and] the two fender portions," and "a unitary inner panel ... further defining the hood portion and the two fender portions." Accordingly, the analyses presented for claims 1 and 2 also apply to claim 8. Applicants therefore submit that claim 8 is allowable.

Claims 9-21 ultimately depend from claim 8 and are therefore allowable for at least the same reasons that claim 8 is allowable.

Moreover, claim 12 recites "a front bumper ... wherein the outer panel depends downwardly from the hood portion to extend forward of the front bumper and thereby conceal the front bumper from view." The Examiner states that Bailey discloses "that the hood panel conceals the front 'bumper' (69 in Fig. 2). . . ." However, reference number 69 in Figure 2 of Bailey refers to an area of the frame that is broken away for illustrative purposes: "In Figure 2, the frame 7 is broken away at 69 to show the connection of 54, 33, and 34." Bailey, column 4, lines 19-21. Thus, the Examiner is

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referring to a portion of the frame as being a "bumper." It is apparent that the chassis frame 7 of Bailey at 69 is not a "front bumper" as recited in claim 12. Bailey is clear that the front bumper is element 31, which is not concealed by the hood 18, but rather protrudes prominently forward of the hood 18. See Bailey, column 3, lines 25-28, and Figure 1. Thus, the references cited by the Examiner do not teach or suggest all of the elements recited by claim 12, and accordingly, Applicants submit that the obviousness rejection of claim 12 is improper.

Claims 18, 20, and 22 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Bailey in view of Hayata, and further in view of Alamagny. Claim 18 recites "a lower front cross member and two front hinge pillars, and wherein the body panel is connected to the lower front cross member and the two front hinge pillars." The Examiner admits that "Bailey, Jr. as modified does not disclose that the hood panel is hingedly mounted to the front lower cross member." The Examiner then states that "Alamagny discloses a vehicle hood panel which is hingedly mounted along a lower front cross member."

The rejection of claim 18 is improper because neither the hood 18 of Bailey nor the hood members A and B of Alamagny is connected to front hinge pillars, as recited by claim 18. Rather, Bailey merely states that hood 18 is connected via links 19 to the body 11; Bailey does not disclose that the links are connected to the front hinge pillars of the body 11. See Bailey, column 2, line 50 – column 3, line 5. The figures of Bailey are highly schematic, and it cannot be concluded from the figures that the links 19 connect the hood 18 to the front hinge pillars. The links 19 appear to be connected to a cowl member or to a forward bulkhead. Similarly, piston rod 28 of Bailey is connected to the body 11 via pivot 29; however, Bailey does not disclose that the rod and pivot are connected to the front hinge pillar. See Bailey, column 3, lines 10-15. Indeed, it is apparent from Figure 2 of Bailey that the rod 28 connects to the body at a bulkhead, and not at the front hinge pillar as recited by claim 18. The vehicle of Alamagny does not include front hinge pillars. Accordingly, the references cited by the Examiner fail to

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teach or suggest all the limitations of claim 18, and Applicants therefore submit that claim 18 is allowable.

Claim 19 depends from claim 18 and is therefore allowable for at least the same reasons that claim 18 is allowable.

Claim 22 recites "the body panel being mounted to the lower front cross member and the two front hinge pillars. . . ." Accordingly, the analysis presented for claim 18 also applies to claim 22.

New claim 24 recites a "latch operatively connected to the front hinge pillar ... configured to releasably engage [a] striker to retain the body panel in the closed position." None of the references cited by the Examiner teaches or suggests a latch operatively connected to a front hinge pillar and configured to releasably engage a striker to retain the body panel in the closed position. Accordingly, Applicants respectfully submit that claim 24 is allowable. Antecedent support for the latch and the striker configuration of claim 24 is found in paragraph 0034 and Figure 6 of the present application. The vehicle of claim 24 minimizes "hard" locations on the upper surface of the body panel because fastening elements such as hinges and/or latches are not along a cowl, as stated in paragraph 0005 of the present application. New claim 24 is a member of elected species A of Invention I.

### **CONCLUSION**

This Amendment is believed to be fully responsive to the Office Action mailed May 13, 2004. The amendments and remarks in support of the rejected and amended claims are believed to place this application in condition for allowance, which action is respectfully requested.

Please charge any fees associated with this amendment to deposit account 07-0960.

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Respectfully submitted

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